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1 RECORD OF ORAL HEARING
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3 UNITED STATES PATENT AND TRADEMARK OFFICE
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5

6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES
8

9

10 *Ex parte* FRANK DIETSCHE, THOMAS JAWOREK, REINHOLD
11 SCHWALM, MARTIN WEBER, and HELMUT STEININGER
12

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14 Appeal 2009-003796
15 Application 10/519,841
16 Technology Center 1700
17

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19 Oral Hearing Held: Thursday, August 13, 2009
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22 Before CATHERINE TIMM, MICHAEL COLAIANNI, and JEFFREY B.
23 ROBERTSON, *Administrative Patent Judges*
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28 ON BEHALF OF THE APPELLANTS:
29

30 FREDERICK VASTINE, ESQ.
31 Oblon, Spivak, McClelland
32 1940 Duke Street
33 Alexandria, Virginia 22314
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1 The above-entitled matter came on for hearing on Thursday,
2 August 13, 2009, commencing at 9:46 a.m., at the U.S. Patent and
3 Trademark Office, 600 Dulany Street, 9th Floor, Hearing Room A,
4 Alexandria, Virginia, before Jon Hundley, Notary Public.

5 THE CLERK: Calendar No. 49, Mr. Vastine.

6 MR. VASTINE: Good morning.

7 JUDGE TIMM: Good morning.

8 Mr. Vastine, if you have a business card for our court reporter,
9 that would be appreciated.

10 MR. VASTINE: I gave it to him.

11 JUDGE TIMM: Oh, great. Thank you.

12 MR. VASTINE: Mm-hmm.

13 JUDGE TIMM: And you have 20 minutes, and you may begin
14 when ready.

15 MR. VASTINE: Okay.

16 The present invention, as they have it, is directed to the
17 technology of clearcoat hard-coat formulations, which, for instance, you
18 might find on an automobile, where you provide that hard, scratch-resistance
19 coating.

20 And so this area has some background to it. But there have
21 been deficiencies in the past, and what Applicants basically have found is
22 that when you have the clearcoat layer with an optional pigmented layer
23 under it, you provide a thermoplastic elastomer underneath that, and that
24 then is bonded to the substrate, which could be a metal. It could also be
25 paper.

1 You have a hard surface coat, which possesses a high degree of
2 scratch resistance. And importantly, because of the presence of that elastic
3 layer underneath, the tendency for propagation of a scratch, any given
4 scratch to move through the coating -- and of course, you'd see the marring
5 effect of that -- is greatly reduced.

6 So the important part is a combination of the hard clear coat and
7 underlying elastic layer.

8 Now as far as the art has been developed in this case, we do not
9 feel that anything like this really has been demonstrated or suggested by the
10 art.

11 One of the primary references we have is the Mack reference,
12 which has been applied. And this discusses a modified filler, of particles of
13 typical -- some organic fillers -- coated with an organosilene. And this
14 serves a purpose of being an adequate or improved filler for incorporation in
15 polyamids.

16 And then of course the filled polyamide is injection-molded.

17 Well, this really doesn't have anything to do with a clearcoat
18 multi-coat system.

19 JUDGE TIMM: I think the Examiner is relying on that
20 reference as the substrate and for its impact resistance. Is that correct?

21 MR. VASTINE: Well, it may be. But that still does not make
22 it a clearcoat. The filler is a filler for a polyamide. Now whether you coat it
23 on something, that --

1 JUDGE TIMM: Well, I think the Examiner is -- the proposed
2 combination is with the Otachi reference teaching a clearcoat upon the
3 hologram.

4 And then you would put the hologram on top of the molded
5 device of Mack.

6 MR. VASTINE: Well, we don't believe it's that clear-cut. In
7 Otachi -- well, first of all, a hologram has nothing to do with this invention.
8 Where you have -- in a hologram, of course -- say on a credit card you have
9 an overlying layer, and then you have that hologram effect of the layer
10 underneath.

11 But that shows the structure of the substrate, where the
12 hologram layer is bonded to the substrate with a pressure-sensitive adhesive,
13 which the elastic layer is not.

14 On top of the hologram layer is another pressure-sensitive
15 adhesive. But these pressure-sensitive adhesives require tackifiers in
16 combination with an elastomeric material or rubber. And that is not a part of
17 the invention.

18 So we have real difficulty with making this kind of leap with
19 combination --

20 JUDGE TIMM: What in terms of your claim would distinguish
21 from a pressure-sensitive adhesive containing a thermoplastic elastomer?

22 MR. VASTINE: Well, it is elastic per se, as a thermoplastic. It
23 does not contain the tackifier. And those of skill in the art were readily
24 aware of that. It's in no way a pressure-sensitive adhesive.

1 JUDGE TIMM: In terms of your claim, is there anything in
2 your claim that distinguishes from that pressure-sensitive adhesive?

3 MR. VASTINE: Well, it would -- in terms of having an elastic
4 undercoat, you have the top layer of the elastic undercoat. And then having
5 the impact strength characteristic and the intercoat -- that ratio lends
6 definition to what the product is.

7 And as I say, this is a very impact-resistant material,
8 scratch-resistant. And on that basis, we believe that the term "underlying
9 elastic coat" would be distinguished. Well, one who is skilled in the art
10 would recognize it's not a pressure-sensitive adhesive, in other words, which
11 is a several-component formulation.

12 JUDGE TIMM: Does your claim exclude other components
13 within the elastic intercoating?

14 MR. VASTINE: What, again?

15 JUDGE TIMM: Does your claim exclude the presence of other
16 additives within the elastic intercoat?

17 MR. VASTINE: Well, not in -- but we talk about it, I mention
18 an elastic intercoat. Based on what the specifications states, I think it's clear
19 that the term "elastic" would not be supported by a specification that
20 describes pressure-sensitive adhesive formulations, for instance, where you'd
21 have a tackifier, and this, that, and the other thing.

22 JUDGE TIMM: Your specification talks about the polymer as
23 having the required glass transition temperature of your claim?

24 MR. VASTINE: Yes.

1 JUDGE TIMM: Your claim requires that the elastic intercoat
2 have that particular glass transition temperature.

3 MR. VASTINE: Mm-hmm.

4 JUDGE TIMM: What is the interplay between what's disclosed
5 in your specification and the claim? Your specification does state that you
6 can have other additives within that inner layer coat. So --

7 MR. VASTINE: But not mentioned is -- well, perhaps it could
8 have some other things, but at least it does not supplant or suggest that it
9 be -- it could be a pressure-sensitive system, that it is an elastomeric.

10 And I think a low softening point, a low-Tg thermoplastic
11 would be indicative of one that, particularly in some external environments,
12 in other words maintains that elasticity, and at compatibly low temperatures.

13 So, again, I don't see that in the term, pressure-sensitive
14 adhesive, where --

15 JUDGE TIMM: Well, I think the Examiner's point is that the
16 particular thermoplastic elastomers disclosed in the references as being used
17 in the pressure-sensitive adhesive, are the same as the thermoplastic
18 elastomer you disclose as having the glass transition temperature of your
19 claim.

20 And on that basis, the Examiner is saying that it meets your
21 claim limitation.

22 MR. VASTINE: Well, I think that's fracturing, frankly, of the
23 disclosure. Because if you're going to have a pressure-sensitive adhesive,
24 it's got to be tacky. And you're going to place a tackifier in there, as well as

1 maybe even another rubbery material or something to make it as such, so
2 that it can function as a pressure-sensitive adhesive.

3 The elastic layer is not a pressure-sensitive adhesive. It doesn't
4 contain the tackifier.

5 One of skill, reading the spec and the claim, would know that
6 that's the case -- we believe, anyway.

7 So there is a distinction between a pressure-sensitive adhesive
8 and the elastic intercoat.

9 JUDGE TIMM: Would a pressure-sensitive adhesive have the
10 property that you're claiming? You are claiming just one property, which
11 you are trying to distinguish, based on, which is the glass transition
12 temperature.

13 MR. VASTINE: Mm-hmm.

14 JUDGE TIMM: Would a pressure-sensitive adhesive have that
15 property?

16 MR. VASTINE: I don't -- well, I haven't studied the list of
17 pressure-sensitive adhesives. I don't know. But from the compositional
18 point of view, what I'm saying is it's a marked difference that there's an
19 exclusion on that basis that the elastic layers and all -- formulative of
20 elastomer that does adhere to the underlying substrate and if there's a
21 pigmented layer on that too.

22 But there's no tackifying function, there's no -- a
23 pressure-sensitive adhesive I guess we all know is -- I mean, you can apply it
24 on a substrate.

1 In fact, one reference shows that, and you have the tacky layer
2 on top. And then you could apply under pressure that adhesive onto
3 whatever you want to bond. Take off maybe the substrate, and then you
4 have it. But that's not the elastic layer.

5 JUDGE TIMM: Okay. I think we understand your position.

6 MR. VASTINE: Okay.

7 I really covered basically the territory of a number of the
8 references. We don't feel that the Bergh reference or the Van Havenbergh
9 reference, disclosing radiographic screens, has anything to do with the
10 invention.

11 They're not providing such and the structuring is -- well, Bergh
12 has a self-supporting binder plus phosphor particle layer. We don't have
13 phosphors in any layer.

14 So we basically feel they're irrelevant.

15 JUDGE TIMM: Okay.

16 MR. VASTINE: Which basically is our position.

17 JUDGE TIMM: Do you have any further questions?

18 JUDGE COLAIANNI: No questions.

19 MR. VASTINE: All right.

20 JUDGE ROBERTSON: No.

21 JUDGE TIMM: I have one other question.

22 MR. VASTINE: Mm-hmm.

23 JUDGE TIMM: In terms of your claim here, you claim it as a
24 clear coat with an optional coat E? And then on the third line of Claim 1,

1 you say "Said coat comprised of said coating system F and optional coat E
2 constituting a topcoat"?

3 "And at least one elastic intercoat."

4 I'm a little bit confused as to what you're claiming in terms of
5 layer structure. I'm assuming it's the topcoat and the elastic intercoat coat.
6 And the word clearcoat just encompasses that entire structure?

7 MR. VASTINE: Yeah. The top coat is the coating system F.
8 And the optional coating underneath there is the effect substance or
9 pigmented layer.

10 And then, of course, if you had that pigmented layer, then it
11 would be on the elastic intercoat layer D.

12 JUDGE TIMM: Okay. So --

13 MR. VASTINE: I think that --

14 JUDGE TIMM: That language "said coat comprised of said
15 coating system F, and optional coat E" just means that that optional coat E
16 could be within the system with the topcoat and the elastic intercoat?

17 MR. VASTINE: Well, I think, as I understand it, the -- at least
18 one coat E is optional, is different from the radiation-curable coating system
19 F. E underlies F. And of course, E doesn't have to be there.

20 And then the next thing would be the intercoat D layer
21 underneath. I think that's consistent with what's stated here.

22 JUDGE TIMM: Okay.

23 MR. VASTINE: Okay?

24 JUDGE TIMM: All right.

25 MR. VASTINE: All right. Thank you.

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1 JUDGE TIMM: Thank you.

2 Whereupon, at 9:59 a.m., the proceedings were concluded.